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10/593,769

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Yoshinori Endo

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EXAMINER

TO, TUAN C

ART UNIT

PAPER NUMBER

3663

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                    |  |
|------------------------------|--------------------------------------|------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/593,769 | <b>Applicant(s)</b><br>ENDO ET AL. |  |
|                              | <b>Examiner</b><br>TUAN C. TO        | <b>Art Unit</b><br>3663            |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 19-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 19, 22 and 23 is/are allowed.
- 6) ☒ Claim(s) 20, 21 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 20, 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mochizuki (US. 20010037305 A1).

Regarding claim 20, Mochizuki includes all necessary structures and computer system to implement the desired use of the claimed system:

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Mochizuki discloses a navigation system that comprises:

A positioning collection unit (2) for collecting the position information of the mobile unit (52);

an input unit (1) is used for entering the information whether the positioning unit (2) should record the position (paragraph 0244).

a recorded storage device (4) for recording the map data (see paragraph 0310);

a calculating unit (5) of the mobile apparatus (52) shown in figure 1 has capability of calculating the recording data ratio information that is a recording ratio of the map data recorded, and that the recording data as a part of record in the storage device (4) is used for calculating an update charge of map data. For example, the server (51) includes a billing part (103) that is used to calculate an amount of charge for the information related to the selected map data requested from user (see paragraph 0070); and

a recording unit which is the removable-medium drive (10) has capability of recording a ratio of recording data in a storage unit (10). It should be noted that in Mochizuki, the removable-medium drive (10) saves the data stored in the storage (4), and that the saved data can be read as required for reuse in a route guidance (see paragraph 0304). Therefore, storage unit (10) is capable to record a ratio of recording data for the purpose of reusing such the data in route guiding.

Regarding claims 21, and 24, Mochizuki includes all necessary structures and computer system to implement the desired use of the claimed system:

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Mochizuki discloses a navigation system that comprises recorded storage device (4) for recording the map data (see paragraph 0310);

A wireless transmitting unit (30) is capable to transmit the drive information to the server (51) (see figure 1).

a calculating unit (5) of the mobile apparatus (52) shown in figure 1 has capability of calculating the recording data ratio information that is a recording ratio of the map data recorded, and that the recording data as a part of record in the storage device (4) is used for calculating an update charge of map data. For example, the server (51) includes a billing part (103) that is used to calculate an amount of charge for the information related to the selected map data requested from user (see paragraph 0070); and

a recording unit which is the removable-medium drive (10) has capability of recording a ratio of recording data in a storage unit (10). It should be noted that in Mochizuki, the removable-medium drive (10) saves the data stored in the storage (4), and that the saved data can be read as required for reuse in a route guidance (see paragraph 0304). Therefore, storage unit (10) is capable to record a ratio of recording data for the purpose of reusing such the data in route guiding.

The statements of intended use or field of use, "adapted to" clause appeared in the claims is essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ

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530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647 (Bd. Pat. App. & Inter. 1987).

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

### ***Allowable Subject Matter***

Claims 1, 19, 22, and 23 are set in a condition for allowance because neither Chojnacki nor any cited prior art of record discloses or suggests the requirement of the claimed terminal device that comprises a unit adapted to read out the drive history information record in the history information recording unit of the navigation device, and the recording ration from the recording medium of the navigation device, and that unit is adapted to send the drive history information and the recording ration to the information center, and display and update charge of the map data received from the information center device.

### ***Response to Arguments***

In response to the applicant's amendment and arguments regarding the previous cited prior art to Chojnacki, the examiner has found the applicant's remarks is

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persuasive. Thus, claims 1, 19, 22, and 23 are currently set in a condition for allowance.

### ***Conclusions***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan C To whose telephone number is (571) 272-6985. The examiner can normally be reached on from 8:00AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Tuan C To/

Primary Examiner

November 12, 2009